

49. (New) The method of claim 47 wherein said polyolefinic compound contains at least one unsaturation and at least one carboxyl group in the polymer chain is present in an amount from less than 20% by weight to greater than 1% by weight in said polymeric composition.

50. (New) The method of claim 48 wherein said polyolefinic compound contains at least one unsaturation and at least one carboxyl group in the polymer chain is present in an amount from less than 20% by weight to greater than 1% by weight in said polymeric composition.

### **REMARKS**

#### **The Amendments**

The amendment to the written description inserts the number of the United States Patent that issued from the provisional priority application as requested by the Examiner. The amendments to claims 33, 34, 36 and 37 address various issues raised by the Examiner in his May 9, 2002 Office Action, and recasts the claims to clearly set out the applicant's invention. New claims 38 and 39 set out the diene or polyene monomers which the written description supports on page 15, first full paragraph. Claims 40-43 define the carboxylated compounds which the written description supports in the paragraph bridging pages 15 and 16.

Claims 44-46 relate to the inclusion of an organo silane in the coating layer of the claims which the written description supports on page 14 and the paragraph bridging pages 18 and 19. The written description supports claims 47 and 48 relative to the ratios of the carboxyl groups to the unsaturation on page 16, first full paragraph

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whereas claims 49 and 50 relating to the amount of polyolefinic compound in the polymer composition finds support in the paragraph bridging pages 17 and 18.

### **Priority**

The Examiner has requested that applicant amend the first paragraph of the application to indicate the status of the priority provisional application. The present amendment inserts the United States Patent No. for the provisional application.

### **The Information Disclosure Statement**

The Examiner has not considered two of the documents included with the December 14, 2002 Information Disclosure Statement because they do not contain the dates of publication.

Applicant advises that the PCT Written Opinion of November 11, 1998 cited "Taschenbuch der Kunststoff -Additive". The publication "DYNASYLAN organofunctional silanes. . .," comes from Hüls- "Application of organofunctional silanes" (1990). Applicant therefore requests the Examiner to consider the foregoing two publications.

### **Oath/Declaration**

The Examiner requires a new oath or declaration, contending that the oath submitted with the present application does not comply with 37 C.F.R. §1.67(a) in that it fails to identify the previously filed application. Applicant traverses this requirement since he filed the present application pursuant to 37 C.F.R. §1.53(b) which provides in part that applicant can file such an application "under the conditions specified in 35

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U.S.C. §120 [and] 121. . . ." Title 35 of the United States Code provides in this regard "[i]f a divisional application is directed solely to subject matter described in the original application as filed, the Director may dispense with signing and execution by the inventor." (35 U.S.C. §121) (emphasis added) The Director has dispensed with signing and execution by the inventor as noted in M.P.E.P. Sec. 201.06(c) p. 200-35,, August 2001, which states that applicants need only file a copy of the oath submitted in the previous application. The application as filed contains a true copy of the original Declaration.

#### Drawings

The Examiner requests an amended Figure 1 to show the proper cross-hatching. Applicant has attached an amended drawing in this regard.

#### Specification

The Examiner requires correction of various spelling errors and run on sentences in the specification. The Examiner also requires capitalization of the various trademarks and a generic description of the materials on pages 14, 16 and 26 of the written description. Applicant will make appropriate amendments in this regard upon the indication of allowable subject matter.

#### Claim Objections

The Examiner objects to the misspelling of the term "polymerizaton" in claim 36. The present amendment makes the spelling correction.

**The Rejection Under 35 U.S.C. §112, Second Paragraph and Traverse**

The Examiner rejects claims 33-43 under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly the subject matter which applicant regards as the invention. The amendments to the claims address each of the Examiner's rejections, and accordingly applicant requests withdrawal of the rejection.

**The Rejection Under 35 U.S.C. §102 and Traverse**

The Examiner rejects claim 33 under 35 U.S.C. §102(b) as anticipated by Hashimoto et al., United States Patent No. 5,561,185 ("Hashimoto"). Applicant traverses the rejection and requests further consideration and reexamination.

Hashimoto describes a fire retardant resin composition having:

- (a) 20 to 60 percent by weight of a polypropylene-series resin;
- (b) 1 to 20 percent by weight of a polyethylene modified with an unsaturated carboxylic acid or its derivative;
- (c) 35 to 65 percent by weight of a metal hydrate, and
- (d) an ethylene series copolymer.

Hashimoto describes various properties of the composition in column 2, lines 42 et seq. as "good in workability of the covering layer at the end of the covered wire in the step of removing the covering layer. . . ."

The polyethylene modified within unsaturated carboxylic acid or its derivative (component (b) of the Hashimoto composition) does not have an unsaturated position in the polymer chain whereas the invention of the present application relates to a method

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of forming an electrical conductor having a coating layer with the property of strippability, which incorporates a polyolefinic compound containing at least one unsaturation and at least one carboxyl group in the polymer chain. Butadiene exemplifies one of these polyolefinic compounds and, when polymerized, contributes an unsaturated position to the polymer chain unlike the polyethylene of Hashimoto. Lacking this unsaturated position in the polymer chain, Hashimoto does not anticipate applicant's method of forming a coating on an electrical conductor having the property of strippability.

#### **The Rejection Under 35 U.S.C. §103 and Traverse**

The Examiner rejections claims 34-43 under 35 U.S.C. §103(a) as unpatentable over Hashimoto in view of Hoshi et al., United States Patent No. 4,801,539 ("Hoshi").

Applicant traverses the rejection and requests further consideration and reexamination.

Hoshi describes a flame retardant olefinic resin composition that includes:

- (a) 100 parts by weight of an olefinic resin and a silane-grafted polymer;
- (b) 50 to 300 parts by weight of a hydrated metal compound;
- (c) 0.1 to 30 parts by weight of a dicarboxylic acid or "dicarboxylic acid anhydride derivative."

(Hoshi, column 2, lines 57-65.)

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Hoshi goes on to describe:

The olefinic resin composition of the present invention is characterized in that it can prevent the surface deterioration and surface attack by chemicals in electric wires and cables when the present composition is used for these wires and cables, because it comprises a silane-grafted polymer and a dicarboxylic acid or dicarboxylic acid anhydride derivative.

(Hoshi, column 2, lines 66-68, column 3, lines 1-4.)

Hoshi, however, does not mention anything about the strippability problem addressed by the present invention.

#### **The References Provide No Motivation to Combined Their Teachings**

The references provide no motivation for a person of ordinary skill in the art to combine or modify their teachings and arrive at appellant's invention, nor do they teach the desirability of the combination, or that an advantage or expected beneficial result would have followed from their combination. M.P.E.P. §§ 2143, 2143.01, 2143.02, and 2144, and cases cited therein.

The Examiner "has to point to some teaching, suggestion or motivation in the prior art to select and combine the references that . . . [she] relied on to show obviousness." In re Lee, No. 00-1158 slip op. at 4 (Fed. Cir., January 18, 2001) (emphasis added). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness... 'the central question is whether there is a reason to combine references.'" Lee, slip op. at 5 (emphasis added) (citation omitted).

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The combination of references does not make applicants' invention obvious since the prior art does not suggest the desirability of the combination to obtain a strippable coating (M.P.E.P. Section 2143.01, citing In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990)), nor a reasonable expectation that the combination would produce a strippable coating (M.P.E.P. Section 2143.02, and cited authorities) or that some advantage or expected beneficial result would have been produced by the combination. (M.P.E.P. Section 2144, citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1, 5-6 (Fed. Cir. 1983)).

In rejecting the claim on a combination of Hashimoto and Hoshi, the Examiner cannot point to any teaching in Hoshi relative to strippability that would prompt a person with ordinary skill in the art to combine those teachings with Hashimoto. One reference (Hashimoto) includes strippability as one of the properties of the polymer whereas the Hoshi reference contains no such teaching.

#### Additional References

The Examiner has cited additional references but has not applied them to reject any of the claims. Accordingly, applicant does not deem it necessary to discuss these references.

#### Conclusions

Applicant requests that the Examiner withdraw the objections and rejections in view of the foregoing amendments and remarks.

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If entry of this amendment requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension of time fee or other fee, any of which this amendment fails to account for, applicant's attorneys request such an extension and payment of any fees due from their Deposit Account No. 06-0916.

Respectfully submitted,

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By:   
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Reg. No. 23,057

Dated : August 9, 2002

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PATENT

Customer No. 22,852

Attorney Docket No. 08719.0094-01000

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
 )  
 Luigi CAIMI ) Group Art Unit: 2831  
 )  
 Serial No.: 09/925,528 ) Examiner: William H. Mayo, III  
 )  
 Filed: August 10, 2001 )  
 )  
 For: CABLE WITH FIRE-RESISTANT, )  
 MOISTURE-RESISTANT )  
 COATING )

Commissioner for Patents and Trademarks  
 Washington, DC 20231

**SUBMISSION OF MARKED UP VERSION OF AMENDMENTS TO THE WRITTEN  
 DESCRIPTION AND CLAIMS PURSUANT TO 37 C.F.R. §1.121**

Sir:

Applicant submits the following marked up version of amendments to the written description and claims pursuant to 37 C.F.R. § 1.121 to accompany the amendment in response to the May 9, 2002 communication from the Examiner.

**IN THE WRITTEN DESCRIPTION:**

Page 1, first paragraph: subparagraph --This application is a continuation of International Application No. PCT/EP 98/01443, filed March 12, 1998 based on and which claims the benefit of United States Provisional Application 60/050,956, filed June 16, 1997, and refilled as nonprovisional application Serial No. 09/396, 683 on September 10, 1999, now United States Patent No. 6,339,189 issued January 15, 2002, said United States Provisional Application being based on Italian Application M197

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A00559 filed March 13, 1997, the contents of all of which are incorporated herein by reference.--

**IN THE CLAIMS:**

Please amend the claims as follows:

33. (Amended Twice) A method for controlling strippability of [In an electric conductor having] a coating layer [with] on an electric conductor, said coating layer having the property of strippability so that it can be stripped from said electric conductor, [a method for controlling said strippability of said coating layer from said electric conductor], the electrical insulation properties of said [cable] coating layer being kept constant after exposure to moisture, said method comprising adding to a polymeric composition forming said coating layer, a predetermined amount of a polyolefinic compound which contains at least one unsaturation and at least one carboxyl group in the polymer chain.

34. (Amended Once) The method of claim 33 where said polyolefinic compound which contains at least one unsaturation and at least one carboxyl group in the polymer chain is derived from the polymerization of a diene or polyene monomer containing from 4 to 16 carbon atoms, [said carboxyl group derived from reaction of a carboxylated compound with said unsaturated polyolefin, said carboxylated] with a compound containing at least one carboxyl group and at least one unsaturation.

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35. The method of claim 34 wherein said diene or polyene monomers are butadiene, pentadiene, hexadiene, hexatriene, heptadiene, heptatriene, octadiene, octatriene, and mixtures thereof.

36. (Amended Once) The method of claim 35 where said [polymers have] polyolefinic compound has a [polyerization] polymerization number of 10 to 1000.

37. (Amended Once) The method of clam 36 where said [polymers have] polyolefinic compound has a polymerization number of 20 to 50.

38. The method of claim 35 where said diene or polyene monomers are 1,3-butadiene, 1,3-pentadiene, 1,4-pentadiene, 1,3-hexadiene, 1,4-hexadiene, 1,5-hexadiene, or 2,4-hexadiene.

39. The method of claim 37 wherein said monomer is 1,3-butadiene.

40. The method of one of claims 34, 35, 38 or 39 wherein said carboxylated compound is an anhydride of an unsaturated carboxylic or unsaturated dicarboxylic acid.

41. The method of one of claims 34, 35, 38, and 39 where said carboxylated compound is maleic anhydride.

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42. The method of one of claims 34, 35, 38, or 39 wherein said carboxylated compound is benzoic anhydride.

43. The method of one of claims 34, 35, 38 or 39 wherein said carboxylated compound is acetic anhydride.

44. (New) The method of claim 40 including an organo silane having functionalities which interact with said polymeric composition.

45. (New) The method of claim 44 wherein said silane is  $\gamma$ -methacryloxypropyltrimethoxysilane, methyltriethoxysilane, methyltris (2-methoxyethoxy)silane, dimethyldiethoxysilane, vinyltris(2-methoxyethoxy)silane, vinyltrimethoxysilane, vinyltriethoxysilane, octyltriethoxysilane, isobutyltriethoxysilane, and isobutyltrimethoxysilane, and mixtures thereof

46. (New) The method of claims 44 wherein said silane is present in an amount between 0.05 percent and 1.5 percent by weight of said polymeric composition.

47. (New) The method of claim 40 wherein the ratio of said carboxyl groups to said unsaturation ranges from 1:10 to 1:100 in said polyolefinic compound which contains at least one unsaturation and at least one carboxyl group in the polymer chain.

48. (New) The method of claim 40 wherein the ratio of said carboxyl groups to said unsaturation ranges from 1:10 to 1:50 in said polyolefinic compound which contains at least one unsaturation and at least one carboxyl group in the polymer chain.

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49. (New) The method of claim 47 wherein said polyolefinic compound contains at least one unsaturation and at least one carboxyl group in the polymer chain is present in an amount from less than 20% by weight to greater than 1% by weight in said polymeric composition.

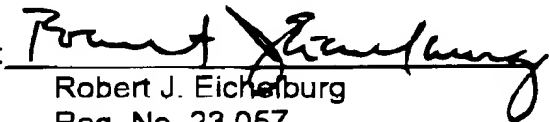
50. (New) The method of claim 48 wherein said polyolefinic compound contains at least one unsaturation and at least one carboxyl group in the polymer chain is present in an amount from less than 20% by weight to greater than 1% by weight in said polymeric composition.

### Conclusions

If entry of this submission requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension of time fee or other fee, any of which this submission fails to account for, applicant's attorneys request such an extension and payment of any fees due from their Deposit Account No. 06-0916.

Respectfully submitted,

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